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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 09/902,769 | 07/12/2001 | Mary E. Goulet | 07220001AA | 1347 |

30743 7590 10/20/2004

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EXAMINER

BORISSOV, IGOR N

ART UNIT PAPER NUMBER

3629

DATE MAILED: 10/20/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/902,769

Applicant(s)

GOULET, MARY E.

Examiner

Igor Borissov

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Handwritten signature

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 03 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 03 August 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,2,4-9,14-18 and 21-23 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,2,4-9,14-18 and 21-23 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION***Response to Amendment***

Amendment received on 8/03/2004 is acknowledged and entered. Claims 3, 10-13 and 19-20 have been canceled without prejudice or disclaimer. Claims 1-2, 4, 9 and 14-15 have been amended. Claims 1, 2, 4-9, 14-18 and 21-23 are currently pending in the application.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 14, 15 and 17 are rejected under 35 U.S.C. 102(e) as being anticipated by Matsukawa (US 2001/0042017 A1).

Claim 14. Matsukawa teaches advertisement distribution method and system, and discusses advantages of distributing an advertisement electronically in comparison to distributing a permanent non-paper announcement item, such as a towel, having the company information printed on said towel [0013]. Information as to the type of the towel, such as *beach* towel, and the content of said printed information, such as *an Internet domain name relating to a theater show, wherein the name is for an Internet website on which appears content relating to the theater show*, is non-functional language and given no patentable weight. Non-functional descriptive material cannot render non-obvious an invention that would otherwise have been obvious. See: *In re Gulack* 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983) *In re Dembiczak* 175 F.3d 994, 1000, 50 USPQ2d 1614, 1618 (Fed. Cir. 1999).

Claim 15. Same reasoning as for claim 14.

Claim 17. Matsukawa teaches: an Internet site for posting a musical piece [0004]; [0011]. Information as to *at least one song clip of a tune from the show* is non-functional language and given no patentable weight. Non-functional descriptive material cannot render non-obvious an invention that would otherwise have been obvious. See: *In re Gulack* 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983) *In re Dembiczak* 175 F.3d 994, 1000, 50 USPQ2d 1614, 1618 (Fed. Cir. 1999). The specific example of non-functional descriptive material is provided in MPEP 2106, Section VI: (example 3) a process that differs from the prior art only with respect to non-functional descriptive material that cannot alter how the process steps are to be performed. The method steps, disclosed in Matsukawa would be performed the same regardless of the type or content of the musical piece.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-2, 4, 6-7 and 9 are rejected under 35 U.S.C. 102(e) as being unpatentable over Matsukawa.

Matsukawa teaches said advertisement distribution method and system, comprising:

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Claim 1. Providing access to a musical piece (show) over the Internet [0004]; [0011]. Matsukawa's invention does not specifically teach a step of: *distributing a permanent non-paper announcement item for the site*. However, Matsukawa teaches advantages of distributing an advertisement electronically in comparison to distributing a permanent non-paper announcement item, such as a towel, having the company information printed on said towel [0013]; thereby disclosing said *distributing* step. It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Matsukawa to include distributing an advertisement as a permanent non-paper announcement item, such as a towel, having the company information printed on said towel, because it would advantageously allow to reach those consumers who do not like to use computers, thereby potentially increase revenue.

Information as to *theater show* is non-functional language and given no patentable weight. Non-functional descriptive material cannot render non-obvious an invention that would otherwise have been obvious. See: *In re Gulack* 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983) *In re Dembiczak* 175 F.3d 994, 1000, 50 USPQ2d 1614, 1618 (Fed. Cir. 1999). The specific example of non-functional descriptive material is provided in MPEP 2106, Section VI: (example 3) a process that differs from the prior art only with respect to non-functional descriptive material that cannot alter how the process steps are to be performed. The method steps, disclosed in Matsukawa would be performed the same regardless of the type or content of the musical piece.

Claim 2. See claim 1. Information as to a *beach* towel is non-functional language and not given patentable weight. Non-functional descriptive material cannot render non-obvious an invention that would otherwise have been obvious. See: *In re Gulack* 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983) *In re Dembiczak* 175 F.3d 994, 1000, 50 USPQ2d 1614, 1618 (Fed. Cir. 1999). The method steps, disclosed in Matsukawa would be performed the same regardless of the type of the towel.

Claim 4. Distributing an advertisement of the musical piece electronically via the Internet, or distributing an advertisement as a permanent non-paper announcement item, such as a towel, having the company information printed on said towel, obviously indicates promoting of said musical piece [0004]; [0011]; [0013].

Information as to *a new musical theater work* is non-functional language and given no patentable weight. Non-functional descriptive material cannot render non-obvious an invention that would otherwise have been obvious. See: *In re Gulack* 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983) *In re Dembiczak* 175 F.3d 994, 1000, 50 USPQ2d 1614, 1618 (Fed. Cir. 1999). The specific example of non-functional descriptive material is provided in MPEP 2106, Section VI: (example 3) a process that differs from the prior art only with respect to non-functional descriptive material that cannot alter how the process steps are to be performed. The method steps, disclosed in Matsukawa would be performed the same regardless of the type or content of the musical piece.

Claim 6. Distributing an advertisement as a permanent non-paper announcement item, such as a towel, obviously indicates distributing a *reusable* item.

Claim 7. Providing printed information on the towel obviously indicates providing *observable by others* information on the towel.

Claim 9. Said method, wherein the site includes a musical piece [0004]. Information as to *one musical sample clip of a tune from the show* is non-functional language and given no patentable weight. Non-functional descriptive material cannot render non-obvious an invention that would otherwise have been obvious. See: *In re Gulack* 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983) *In re Dembiczak* 175 F.3d 994, 1000, 50 USPQ2d 1614, 1618 (Fed. Cir. 1999). The specific example of non-functional descriptive material is provided in MPEP 2106, Section VI: (example 3) a process that differs from the prior art only with respect to non-functional descriptive material that cannot alter how the process steps are to be performed. The method

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steps, disclosed in Matsukawa would be performed the same regardless of the type or content of the musical piece.

Claims 5 and 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Matsukawa in view of Deitrickson (US 2002/0165797 A1).

Claims 5 and 18. Matsukawa teaches all the limitations of claims 5 and 18, including the Internet website relating to the musical piece (show), except teaching that *tickets for said musical piece (show) can be purchased over the Internet.*

Deitrickson teaches an interactive marketing method and system, wherein a consumer uses a website to purchase tickets for concerts [0037].

It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Matsukawa to include *purchasing tickets for said musical piece (show) over the Internet*, as disclosed in Deitrickson, because it would advantageously allow the consumer to purchase said tickets at any convenient for him/her time at home.

Information as to *a new musical theater work* is non-functional language and given no patentable weight. Non-functional descriptive material cannot render non-obvious an invention that would otherwise have been obvious. See: *In re Gulack* 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983) *In re Dembiczak* 175 F.3d 994, 1000, 50 USPQ2d 1614, 1618 (Fed. Cir. 1999). The specific example of non-functional descriptive material is provided in MPEP 2106, Section VI: (example 3) a process that differs from the prior art only with respect to non-functional descriptive material that cannot alter how the process steps are to be performed. The method steps, disclosed in Matsukawa in view of Deitrickson would be performed the same regardless of the type or content of the musical piece.

Claims 8 and 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Matsukawa in view of Sheppard, JR. (US 2003/0131901 A1).

Claims 8 and 16. Matsukawa teaches: printing company information onto towels [0013].

Matsukawa does not specifically teach that printing includes *embroidering* company information onto the towels.

Sheppard, JR. (hereinafter Sheppard) teaches a method for making woven textile with graphic impression, including a towel having names and messages embroidered thereon [0005].

It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Matsukawa to include *embroidering* company information onto the towels, as disclosed in Sheppard, because embroidered messages have advantageously a neater and more appealing appearance, as specifically taught in Sheppard [0005]. Information as to *the Internet site address* is non-functional language and given no patentable weight. Non-functional descriptive material cannot render non-obvious an invention that would otherwise have been obvious. See: *In re Gulack* 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983) *In re Dembiczak* 175 F.3d 994, 1000, 50 USPQ2d 1614, 1618 (Fed. Cir. 1999).

Response to Arguments

Applicant's arguments filed 8/03/2004 have been fully considered but they are not persuasive.

In response to applicant's argument that Matsukawa does not teach a *theater show*, it is noted that Matsukawa discloses a musical piece. Information as to *musical show* is non-functional language and given no patentable weight. Non-functional descriptive material cannot render non-obvious an invention that would otherwise have been obvious. See: *In re Gulack* 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983) *In re Dembiczak* 175 F.3d 994, 1000, 50 USPQ2d 1614, 1618 (Fed. Cir. 1999). The specific example of non-functional descriptive material is provided in MPEP 2106, Section VI: (example 3) a process that differs from the prior art only with respect to non-

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functional descriptive material that cannot alter how the process steps are to be performed. The method steps, disclosed in Matsukawa would be performed the same regardless of the type or content of the musical piece.

In response to applicant's argument that Matsukawa does not teach *promoting a theater show*, the examiner maintains that distributing an advertisement of the musical piece electronically via the Internet, or distributing an advertisement as a permanent non-paper announcement item, such as a towel, having the company information printed on said towel, obviously indicates promoting of said musical piece [0004]; [0011]; [0013].

In response to applicant's argument that Matsukawa does not teach *a beach towel... including an Internet website on which appears content relating to the musical piece (show)*, the examiner stipulates that Matsukawa teaches a towel having the company information printed on said towel [0013], wherein said company provides access to a musical piece (show) over the Internet. Information as to the content of said printed information, is non-functional language and given no patentable weight. Non-functional descriptive material cannot render non-obvious an invention that would otherwise have been obvious. See: *In re Gulack* 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983) *In re Dembiczak* 175 F.3d 994, 1000, 50 USPQ2d 1614, 1618 (Fed. Cir. 1999).

In response to applicant's argument that Matsukawa does not teach theatrical ticket sales, it is noted that Deitrickson was applied to show this feature.

In response to applicant's argument that there is no suggestion to combine Matsukawa and Deitrickson, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one

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of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, both references relate to an interactive marketing or promotional method, wherein customers can access a website relating to a musical piece (concert). Matsukawa's method would benefit from Deitrickson by advantageously allowing the consumers to purchase said tickets at any convenient for the consumers time at home.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication should be directed to Igor Borissov at telephone number (703) 305-4649.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Receptionist whose telephone number is (703) 872-9306.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's Supervisor, John Weiss, can be reached at (703) 308-2702.

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Any response to this action should be mailed to:

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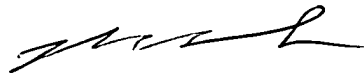
or faxed to:

(703) 872-9306 [Official communications; including After Final
communications labeled "Box AF"]

Hand delivered responses should be brought to Crystal Park 5, 2451 Crystal
Drive, Arlington, VA, 7th floor receptionist.

IB

10/18/2004



JOHN G. WEISS
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